

INTERFERENCE DIGEST

Interference No. 104,819

Paper No. 38

Name: Michel Perricaudet et al.

Serial No.: 08/397,225

Patent No.

Title: Defective adenovirus vectors and use thereof in gene therapy

Filed: 03/28/95

Interference with Saito et al.

DECISION ON MOTIONS

Administrative Patent Judge, _____ Dated, _____

FINAL DECISION

Board of Patent Appeals and Interferences, favorable Dated, 5-2-02

Court, _____ Dated, _____

REMARKS

This should be placed in each application or patent involved in interference in addition to the interference letters.



UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Carol A. Spiegel
Telephone: (703) 308-9797
Facsimile: (703) 305-0942

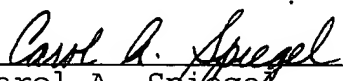
MAILED**MAR 08 2002**

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Applicants: Perricaudet et al.
Application No.: 08/397,225
Filed: 03/28/95
For: Defective adenovirus vectors
and use thereof in gene therapy

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 104,819.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).



Carol A. Spiegel
Administrative Patent Judge

The opinion in support of the decision being
entered today is not binding precedent of the Board.

Paper 1

Filed by: Carol A. Spiegel
Administrative Patent Judge
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

Filed: March 6, 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

IZUMU SAITO, YUMI KANEGAE
and MICHIO NAKAI

MAILED

Junior Party,
Patent 5,700,470

MAR 08 2002

v.

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

AVENTIS PHARMA S.A.

Senior Party
Application 08/397,225

Patent Interference No. 104,819 (CAS)

NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties.

Details of the application(s), patent (if any), reissue application (if any), count(s)

and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

Part B. Judge designated to handle the interference

Administrative Patent Judge Carol A. Spiegel has been designated to handle the interference. 37 CFR § 1.610(a).

Part C. Standing order

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

Part D. Conference call to set dates

A telephone conference call to set dates for taking action in the interference is scheduled for **2:00 p.m. on May 8, 2002** (the call will be initiated from the PTO).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See § 17 of the STANDING ORDER.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE.

Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some mutual agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

Part E. The parties involved in this interference are:

Junior Party

Named inventors: IZUMU SAITO,
YUMI KANEGAE and
MICHIO NAKAI

Patent: U.S. Patent 5,700,470,
issued December 23, 1997,
based on application 08/615,048,
filed March 12, 1996

Title: Recombinant Adenovirus with Removed E2A Gene and
Method of Preparation

Assignee: SUMITOMO PHARMACEUTICALS COMPANY, LIMITED

Accorded Benefit: of JP application 07-276335,
filed September 29, 1995 ..

of JP application 07-084891,
filed March 15, 1995

Attorneys: See last page

Address: See last page

Senior Party

Named Inventors: MICHEL PERRICAUDET,
EMMANUELLE VIGNE and
PATRICE YEH

Application: 08/397,225
filed March 28, 1995

Title: Defective Adenovirus Vectors and Use thereof in Gene
Therapy

Assignee: AVENTIS PHARMA S.A.

Accorded Benefit: of PCT application PCT/FR94/00851,
filed July 8, 1994

of FR application 94/04590,
filed April 18, 1994

of FR application 93/08596,
filed July 13, 1993

Attorneys: See last page

Address: See last page

Part F. Count and claims of the parties

Count 1

The recombinant adenovirus of claim 1 of the '470 Saito patent.

or

The replication defective recombinant adenovirus* of claim 35 of the '225 Perricaudet application.

The claims of the parties are:

Saito: 1-31

Perricaudet: 1-3, 6, 9-30, 33-42

The claims of the parties which correspond to Count 1 are:

Saito: 1-6

Perricaudet: 1-3, 9, 11-18, 28, 30, 35, 40-41

The claims of the parties which do not correspond to Count 1, and therefore are not involved in the interference, are:

Saito: 7-31

Perricaudet: 6, 10, 19-27, 29, 33-34, 36-39, 42

Part G. Heading to be used on papers

The following heading shall be used on papers filed in the interference. See
§ 18 of the STANDING ORDER.

Paper ____¹

Filed on behalf of [name of party]
By: Name of lead counsel, Esq.
Name of backup counsel, Esq.
Street address
City, State, and Zip-Code
Tel:
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

IZUMU SAITO, YUMI KANEGAE
and MICHIO NAKAI

Junior Party,
U.S. Patent 5,700,470

v.

AVENTIS PHARMA S.A.

Senior Party
Application 08/397,225

Patent Interference No. 104,819 (CAS)

TITLE OF PAPER

¹ Leave a blank line because the board assigns the paper number.

Part H. Summary of dates for taking action

Times for taking action are set out in the following sections of the STANDING ORDER:

1. **§ 7:** date for identifying lead and backup counsel.
2. **§ 8:** date for identifying any real party in interest.
3. **§ 9:** date for requesting copies of involved and benefit applications and patents.
4. **§ 17:** date for filing list of proposed preliminary motions.
5. **§ 19:** date for accomplishing certain discovery.
6. **§ 20:** date for filing clean copy of claims.
7. **§ 21:** date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
8. **§ 23:** dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
9. **§ 33:** date for objecting to admissibility of evidence.
10. **§ 34:** date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
11. **§ 35:** dates when cross-examination can take place.
12. **§ 45:** dates for taking action with respect to settlement discussions

Part I. Order form for requesting file copies

FILE COPY REQUEST

Interference 104,819 (CAS)


A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. _____
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

Telephone, including area code: _____

Part J. Signature of administrative patent judge



Carol A. Spiegel
Administrative Patent Judge

Date: March 6, 2002
Arlington, VA

Enc:

Copy of STANDING ORDER

Copy of order used for setting times for taking action in the preliminary motion phase of the interference (ORDERPM6)

Copy of order used for setting times for taking action in the testimony and briefing phases of the interference (ORDERTE6)

Copy U.S. Patent 5,700,470

Copy of claims of 08/397,225

DECLARE.007
Revised September, 2000
(replaces DECLARE.006.1)

Interference No. 104,819
Saito v. Aventis Pharma S.A.

Paper 1
Page 10

cc (via Federal Express):

Attorney for Saito
(real party in interest
SUMITOMO PHARMACEUTICALS COMPANY):

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Attorney for Perricaudet
(real party in interest
AVENTIS PHARMA S.A.):

David Kulik, Esq.
WILEY, REIN & FIELDING, LLP
Intellectual Property Department
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Washington, DC 20006

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 16

Filed by: Trial Section Merits Panel
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

Filed: May 2, 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

IZUMU SAITO, YUMI KANEGAE
and MICHIO NAKAI

Junior Party,
Patent 5,700,470

v.

AVENTIS PHARMA S.A.

Senior Party
Application 08/397,225

MAILED

MAY 2 - 2002

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Patent Interference No. 104,819 (CAS)

Before: SCHAFER, TORCZON and SPIEGEL, Administrative Patent Judges.

SPIEGEL, Administrative Patent Judge.

JUDGMENT PURSUANT TO 37 CFR § 1.662(a)

"Pursuant to 37 C.F.R. § 1.662(a), the party Saito hereby abandons the contest as to Count 1 and claims 1-6 corresponding thereto" (Paper 15). Therefore, it is

ORDERED that judgment on priority as to Count 1 (Paper 1, p. 5), the sole count in the interference, is awarded against junior party IZUMU SAITO, YUMI KANEGAE

cc: (via Fax and Federal Express)

Saito
(real party in interest
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Aventis/Perricaudet
(real party in interest:
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